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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/614,442	07/03/2003	Shannon R. Schwenn	42522.0817	7736

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EXAMINER

WIEKER, AMANDA FLYNN

ART UNIT	PAPER NUMBER
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3743

DATE MAILED: 12/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/614,442

Applicant(s)

SCHWENN ET AL.

Examiner

Amanda F. Wieker

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 37-66 is/are pending in the application.
- 4a) Of the above claim(s) 43-66 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 37-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 July 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 03 July 2003
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 37-42, drawn to a support plate for an orthotic, classified in class 602, subclass 5.
 - II. Claims 43-48, drawn to a connector plate assembly for a hip orthotic, classified in class 602, subclass 23.
 - III. Claims 49-58, drawn to an orthotic brace with a sleeve, classified in class 602, subclass 60.
 - IV. Claims 59-66, drawn to an orthotic brace with an articulated joint and adjustable linking system, classified in class 602, subclass 60.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, Invention I has separate utility such as an orthotic brace for any body part, while Invention II supports the hip. See MPEP § 806.05(d).

3. Inventions I and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, Invention I has separate utility such as an orthotic brace with a support plate for adjustability, while Invention II is an orthotic with a sleeve member to prevent rotational displacement. See MPEP § 806.05(d).

4. Inventions I and IV are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be

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separately usable. In the instant case, Invention I has separate utility such as an orthotic brace with a support plate for adjustability, while Invention IV is an orthotic to control movement of an articulated joint. See MPEP § 806.05(d).

5. Inventions II and III-IV are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, Invention II has separate utility such as an orthotic brace for supporting the hip, while Inventions III-IV are orthoses applied to any part of the body. See MPEP § 806.05(d).

6. Inventions III and IV are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, Invention III has separate utility such as an orthotic with a sleeve member to prevent rotational displacement, while Invention IV is an orthotic to control movement of an articulated joint. See MPEP § 806.05(d).

7. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Groups II-IV, the search required for Group II is not required for Groups III-IV, and the search required for Group III is not required for Groups IV, restriction for examination purposes as indicated is proper.

8. This application contains claims directed to the following patentably distinct species of the claimed invention:

Species A as depicted in Figures 6-8, and

Species B as depicted in Figures 11-12.

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Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claims appear generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

9. During a telephone conversation with Joseph Price on 04 November 2004 a provisional election was made without traverse to prosecute the invention of Group I, claims 37-42.

Affirmation of this election must be made by applicant in replying to this Office action. Claims 43-66 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

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10. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Drawings

11. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because a reference number is missing from the lead line drawn at the top of Figure 1, between reference number "3" and the axis defined as "Z". Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections/Suggestions

12. Claims 37, 40 and 42 are objected to because of the following informalities:

In line 5 of claim 37 a "distal portion" is introduced. Later in claim 37, at lines 9 and 11, this structure is referred to as "the distal end", which lacks sufficient antecedent basis in the claim. This objection would be overcome by amending lines 9 and 11 to recite "the distal portion," as introduced in line 5. It is noted that claim 39 also refers to this structure as a "distal portion".

Claim 37 introduces both a "fastening structure" (line 7), and "a fastener member" (line 10). Because the second fastener element is referred to as "a" fastener "member", it appears that this fastener "member" is not necessarily the same as the "fastening structure" in line 7. If this is an incorrect interpretation of the claim, the claim should be amended to elucidate that the fastening structure and fastener member are necessarily the same structure. Because claim 40 refers to "the fastener member" this is assumed to be the fastener member of claim 37, line 10.

Similarly, because claim 42 introduces "a pair of fastener members," it is assumed that these fastener members are not necessarily the same "fastener member" that is introduced in line 10 of claim 37. If this is an incorrect interpretation of the claim, the claim should be amended to elucidate that the pair of fastener members and the fastener member of claim 37 are necessarily the same structure.

Appropriate correction is required.

13. The following suggestions are made to improve the clarity and readability of the claims.

In claim 38 at line 2, it appears that the phrase "complimentary curved location" may be more accurately characterized as a --complimentary curved portion--, or a --complimentary curved configuration--.

Double Patenting

14. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground

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provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

15. Claims 37-40 are rejected under the judicially created doctrine of double patenting over claims 6-9 of U. S. Patent No. 6,589,195 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: '195 anticipates the subject matter claimed in claims 37-40 of the instant application. '195 discloses all of the subject matter instantly claimed, and further limits the claimed subject matter by limiting the orthosis to a hip orthosis. The '195 patent includes all of the claim limitations, and is more specific than the broad orthosis instantly claimed.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claim Rejections - 35 USC § 102

16. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

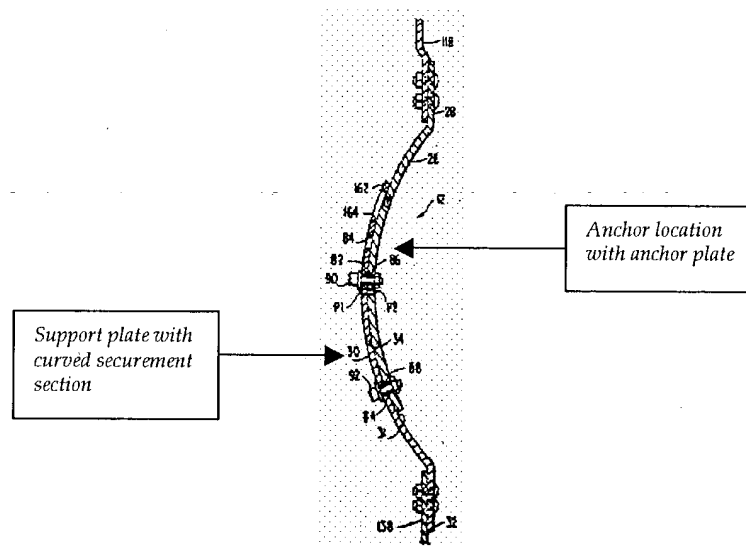
A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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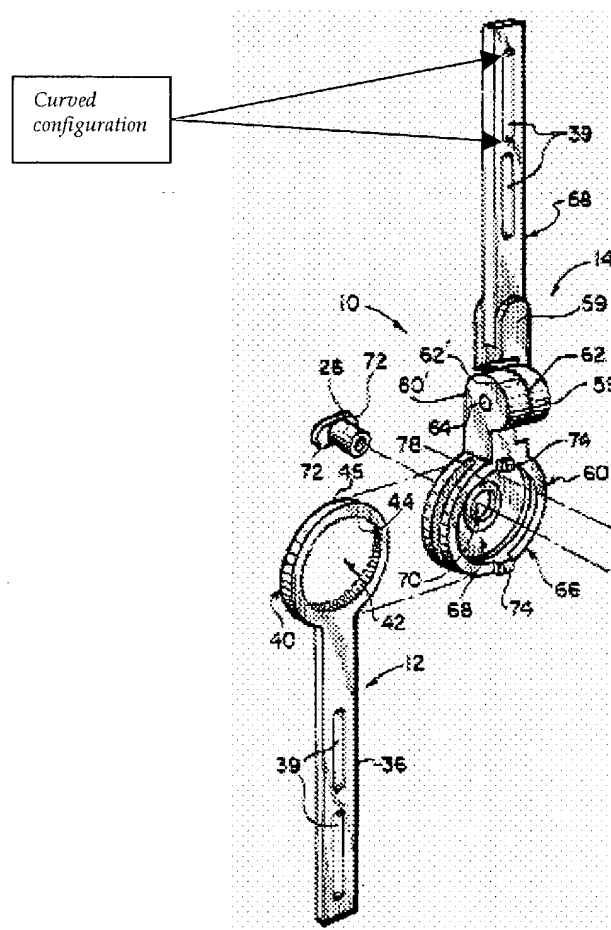
17. Claims 37-39 and 41-42 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent Number 5,107,824 to Rogers et al.

Rogers et al. disclose an orthotic brace having an adjustable support plate assembly for positioning an appendant orthotic member at an operative position relative to an appendage of the user, comprising: a support plate (30) having a securement portion adjacent an anchor location/plate (26) operatively attached to the orthotic brace (110, 112) and a distal portion (32) for linking with the appendant orthotic member (130, 132) which is attachable to the user appendage (calf), the securement portion having a curved configuration (see Fig 5a) and a fastening structure (90, 92) that enables an adjustable movement relative to the anchor location to permit sliding movements of the distal portion towards and away from the user's upper torso. Rogers et al. also disclose a fastener member (166) for securing the curved configuration to the anchor location to maintain a desired position for the distal portion relative to the user. The anchor location/plate (26) is complementary to the curved configuration of the securement portion of the support plate (30), and receives the fastener member (166). The support plate (30) has a straight distal portion (32). The securement portion has a pair of elongated slots (82, 84) and a pair of fastener members (90, 92) is configured to fit within the elongated slots and fasten to the anchor location/plate (26).



18. Claims 37, 39-40 and 42 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Number 6,203,511 to Johnson et al.

Johnson discloses an orthotic brace (106) having an adjustable support plate assembly for positioning an appendant orthotic member (38) at an operative position relative to an appendage of the user, comprising: a support plate (58/36) having a securement portion adjacent an anchor location on the orthotic brace (106) and a distal portion (36) for linking with the appendant orthotic member (38) which is attachable to the user appendage, the securement portion having a curved configuration (see below; slots 39 comprise a curved configuration at the top and bottom of the slot) and a fastening structure (105) that enables an adjustable movement relative to the anchor location to permit sliding movements of the distal portion towards and away from the user. Rogers et al. also disclose a fastener member (105) for securing the curved configuration to the anchor location to maintain a desired position for the distal portion relative to the user. The support plate (58/36) has a straight distal portion (36). The securement portion has a pair of elongated slots (39) and a pair of fastener members (105) is configured to fit within the elongated slots and fasten to the anchor location.



Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amanda F. Wicker whose telephone number is 703-306-4056. The examiner can normally be reached on Monday-Thursday, 8:30 - 6:00 and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry Bennett can be reached on 703-308-0101. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

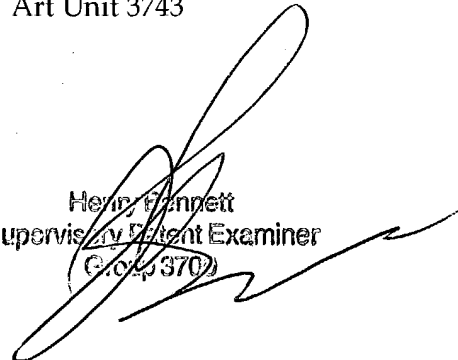


Amanda F. Wieker

Examiner

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afw



Henry Bennett
Supervisory Patent Examiner
(Art Unit 3743)